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In re Application of	:	OFFICE OF PETITIONS
Schmeichel et al.	:	
Application No. 09/930,680	:	DECISION ON PETITION
Filed: August 14, 2001	:	AND RETURN
Attorney Dck't. No. A20-009-01	:	OF THIRD PARTY PAPERS

This is a decision on the petition filed October 12, 2004, by a third party requesting suspension of the rules under 37 CFR 1.183 such that the concurrently filed protest containing an IDS may be considered by the examiner.

The petition under 37 CFR 1.183 is **dismissed**.

Petitioner asserts that it is involved in litigation with the assignee of the above-captioned application and seeks waiver of the requirement that a protest be filed before publication of an application.

37 CFR 1.291(a) provides in pertinent part that "[a] protest specifically identifying the application to which the protest is directed will be entered in the application file if:

- (1) The protest is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first..."

Since the above-identified application was published July 25, 2002, as publication No, US20020096910A1, over two years prior to the filing of the instant protest, the instant protest will not be entered into the file in the absence of waiver of the rules.

In order for grant of any petition under 37 CFR 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Third party petitioner has not shown that either condition exists in this case.

Third party petitioner is reminded that, by its terms, 37 CFR 1.183 may not be invoked to operate to the contrary of any law. In this instance, attention is directed to 35 U.S.C. § 121(c) which provides that:

PROTEST AND PRE-ISSUANCE OPPOSITION.- The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

As inspection of the protest fails to reveal that third party petitioner has obtained the express written consent of the applicant in this matter, and as this latter requirement is a requirement of law, it is beyond the control or the delegated authority of the USPTO in this instance to further contemplate waiver of the timing requirement of the regulation, for to do so would disregard the above-quoted statutory requirement for belated consideration of a protest in, as here, a published application. Since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute. See A.F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977). That is, the USPTO simply lacks the authority or the discretion to relax any requirement of law. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); A.F. Stoddard v. Dann, Id.

Since the rules will not be waived in this instance and as such the untimely protest is not properly entered in the file, it is being returned herewith.

The \$130 fee for a petition under 37 CFR 1.183 has been charged to petitioner's deposit account. The fee was owed regardless of the outcome of the decision.

On a one time basis, a courtesy copy of this decision is being mailed to counsel who, albeit not of record, filed the petition, notwithstanding the USPTO requirement that once a protest has been filed the USPTO will not further communicate with the third party.

Telephone inquiries relative to this decision should be directed to the undersigned at (703) 305-1820.



Brian Hearn
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cc:

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Enclosure for cc: papers filed October 12, 2004